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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/754,415	01/02/2001	Paul J. Rank	0007056-0054	3147

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EXAMINER

VAUGHN, GREGORY J

ART UNIT	PAPER NUMBER
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2178

DATE MAILED: 01/13/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/754,415	RANK, PAUL J.	
	Examiner	Art Unit	
	Gregory J. Vaughn	2178	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 July 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 07 July 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Application History

1. This action is responsive to the application amendment, filed on 7/7/2004.
2. Applicant has amended claim 8.
3. Claims 1-16 are pending in the case, claims 1 and 9 are independent claims.
4. Applicant has amended the specification and drawings in response to the objections cited by the examiner in the *Drawings* and *Specification* sections of the previous office action (dated 4/7/2004). Applicant's amendment has addressed the objections previously made, and therefore, in view of the amendment, objections to the drawings and specification are withdrawn.
5. Examiner's objection to claim 8, made in the *Claim Objections* section of the previous office action (dated 4/7/2004) is withdrawn in view of the amendment to this claim.
6. Examiner's rejection of claims 1-16, made under 35 USC 102 or 35 USC 103, as being anticipated or unpatentable as recited in the previous office action (dated 4/7/2004) are withdrawn in view of applicant's remarks. New grounds of rejection are described below.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

“(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.”

8. Claims 1-3, 5, 6, 8, 9-11, 13, 14 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Barile et al. US Patent 5,977,886, filed 10/10/1997, patented 11/2/1999 (hereinafter “Barile”) in view of Metz et al. US Patent 5,768,539, filed 12/17/1996, patented 6/16/1998 (hereinafter “Metz”).

9. **Regarding independent claim 1**, Barile discloses determining a subset of a functions from a set of functions associate with a file. Barile recites: *“the code is a member of a code set adaptively selected based on the application”* (column 2, lines 3-10). Barile discloses the input device as a PDA. Barile recites: *“Typically, a keyboard used as a user input device for an application resident on a data processing system, e.g., a program running on a personal computer (PC), a personal digital assistant (PDA) or the like”* (column 1, lines 15-18). Barile discloses storing the subset of functions in Figure 2 at reference sign 250 (shown as “Code Set Storing”). Barile further recites: *“A keycode set is identified at the data processing system, and a message*

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identifying the identified keycode set is communicated from the data processing system to the user input device. In response to a keystroke, a keycode from a keycode set of the plurality of keycode sets stored at the user input device which is identified in the communicated message is communicated" (column 3, lines 2-9).

Barile fails to disclose downloading a file. Metz teaches downloading a file to a PDA. Metz recites: *"The IR transmitter 147 and IR receiver 145 may operate together to provide a two-way wireless data communication link to some remote device, such as a personal data assistant (PDA) or pocket organizer"* (column 25, lines 57-60) and *"The download routine running in the DET microprocessor 110 utilizes these block numbers to place the recovered information in proper order in memory and to recognize the capture of all of the download file"* (column 38, lines 15-19).

Therefore, it would have been obvious, to one of ordinary skill in the art at the time the invention was made to combine the transfer of PDA function subsets of Barile with the transfer of files as taught by Metz in order to provide *"two-way communications with transport of application program code"* (Metz, column 5, lines 15-16).

10. **Regarding dependent claim 2**, Barile recites: *"This and other objects, features and advantages are provided according to the present invention by systems and methods for communicating a user input to an application resident on a data processing system, in which a user input accepted at a user input device is communicated using a code which is a member of a code*

set which is adaptively selected to optimize a performance parameter for communicating user inputs to the application" (column 2, lines 3-10).

11. **Regarding dependent claim 3**, Barile recites: *"For example, a user input device may utilize keycodes for an English-text word processing application in a different fashion than for a word processing application in a different language or a specialized text processing application such as a computer program editor"* (column 2, lines 24-29). Compare *"family of functions"* with *"keycodes for an English-text word processing application"*.
12. **Regarding dependent claims 5 and 6**, Barile recites: *"However, the keyboard 10 and PDA 20 may be used for applications other than English-text word processing. For example, a spreadsheet application may be running on the PDA 20 which involves more numeric keyboard entry than alphabetic character entry ... Therefore, according to the present invention, a different keycode set may be adaptively selected for use with the spreadsheet application"* (column 6, lines 8-17).
13. **Regarding independent claim 9**, the claim is directed toward a computer product for the method of claim 1 and is rejected with the same rationale. Claim 9 further claims a limitation directed toward Spreadsheets. Barile recites: *"Therefore, according to the present invention, a different keycode set may be adaptively selected for use with the spreadsheet application"* (column 6, lines 15-18).

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14. **Regarding dependent claim 10**, the claim is directed toward a computer product for the method of claim 2, and is rejected with the same rationale.
15. **Regarding dependent claim 11**, the claim is directed toward a computer product for the method of claim 3, and is rejected with the same rationale.
16. **Regarding dependent claims 13 and 14**, the claims are directed toward a computer product for the method of claims 5 and 6, and are rejected with the same rationale.
17. **Regarding dependent claims 8 and 16**, the claims are rejected for fully incorporating the deficiencies of the base claims.
18. Claims 4 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Barile in view of Metz and in further view of Bukszar et al. US Patent 6,133,916 (filed 4/8/1998, patented 10/17/2000). "*Bukszar et al.*" is hereafter referred to as "*Bukszar*".
19. **Regarding dependent claim 4**, Barile and Metz disclose determining a subset of functions as described above. Barile and Metz fail to disclose displaying the subset of functions as a list. Bukszar teaches displaying functions as a list. Bukszar recites: "*Alternatively, various functions can be accessed by clicking a mouse button while the mouse pointer is in the vicinity of a graphical representation 46A-E to display a list of functions applicable to the display of the graphical representation*" (column 4, line 64 to column 5, line 1).

Therefore, it would have been obvious, to one of ordinary skill, at the time the invention was made to combine displaying a list of functions, as taught by Bukszar, to the subset of function determination of Barile and Metz to provide the benefit of allowing system users the ability to see and access the available functions of the system.

20. **Regarding dependent claim 12**, the claim is directed toward a computer product for the method of claim 4 and is rejected with the same rationale.

21. Claims 7 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Barile in view of Metz and in further view of Hoffberg et al. US Patent 5,901,246 (filed 6/6/1995, patented 5/4/1999). "*Hoffberg et al.*" is hereafter referred to as "*Hoffberg*".

22. **Regarding dependent claim 7**, Barile and Metz disclose a family of functions as described above. Barile and Metz fail to disclose mathematical, trigonometric, statistical, financial or scientific functions. Hoffberg teaches the use of financial and scientific functions. Hoffberg recites: "*if the text and context of the table indicate that this is a financial table, financial options would be initially provided, and standard financial calculation functions immediately made available or performed, in contemplation of their prospective use. Similarly, if the data appears to be scientific, a different set of options would be initially available, and the standard scientific-type calculation functions be made available or performed*" (column 107, lines 33-40).

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Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the use of financial or scientific functions as taught by Hoffberg with Barile and Metz's family of functions in order to allow users the ability to use built in complex functions.

23. **Regarding dependent claim 15**, the claim is directed toward a computer product for the method of claim 7 and is rejected with the same rationale.

Response to Arguments

24. Applicant's arguments, see page 10, second paragraph, filed 7/7/2004, with respect to the rejections of claims 1 and 9 under 35 USC 102(b) have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Barile and Metz. Metz teaches the missing feature of downloading a file to a PDA.

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Conclusion

25. The following prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

<u>Patent</u>	<u>Date</u>	<u>Inventor</u>
• US-5,708,840	01-1998	Kikinis et al.
• US-5,721,837	02-1998	Kikinis et al.
• US-6,122,349	09-2000	Kredo et al.
• US-6,148,334	11-2000	Imai et al.
• US-6,374,245	04-2002	Park, Hee-young
• US-6,412,008	06-2002	Fields et al.

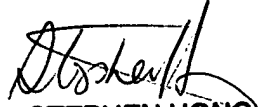
26. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gregory J. Vaughn whose telephone number is (571) 272-4131. The examiner can normally be reached Monday to Friday from 8:00 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen S. Hong can be reached at (571) 272-4124. The fax phone number for the organization where this application or proceeding is assigned is (571) 272-2100.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Gregory J. Vaughn
January 6, 2005



STEPHEN HONG
SUPERVISORY PATENT EXAMINER